

REMARKS

Claims remaining in the present patent application are Claims 1-6 and 13-24. The Applicants respectfully request reconsideration of the above captioned patent application in view of the following remarks.

Response to Arguments

In the “Response to Arguments” section, the rejection argues that Claim 1 is suggested by Larsson Figure 8. Applicants respectfully traverse. Claim 1 recites, inter alia, “b) in response to a request from said first hand-held computer system to establish communication between said first and second hand-held computer systems...”

However, in Figure 8, Larsson requires manual intervention from a user to establish communication, e.g., “Mode 3 requires manual actuation to establish the piconet. ... At step 802, the driver approaches the car, and presses a special key on the handset keypad which is preset to activate car/phone operation” (column 4, line 60 *et seq.*, emphasis added). Accordingly, any taught “establishing” of communication is responsive to the manual button push, and not responsive to a request from a hand-held unit, as recited.

For this reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Moreover, Larsson teaches “[t]he handset may store a list of several car unit identifiers” (column 5 line 1 *et seq.*) As previously presented, Larsson’s handset also “activate(s) car/phone operation” (column 4, line 65 *et seq.*) Thus, one device of Larsson, the “activator” device, also contains the list of identifiers.

In accordance with Claim 1, the recited second hand held device contains a list, and the first hand held device issues a request to communicate. In contrast, Larsson teaches the same device contains a list and “activates” communication. Thus, Larsson fails to teach or suggest the claimed limitations of one device contains a list, and a separate device initiating communication.

For this additional reason, Applicants respectfully assert that Claim 1 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

U.S.C. § 103

Claims 1-3, 3-15 and 19-21 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Larsson (US 6,697,638, "Larsson").

Applicants respectfully assert that Claims 1-3, 3-15 and 19-21 are patentable over the cited art for the following reasons.

With respect to independent Claim 13, Applicants respectfully assert that Larsson fails to teach or suggest the claimed limitations of:

c) establishing a Bluetooth connection between said first and second hand-held computer systems by sending a Bluetooth page message from said second hand-held computer system to said first hand-held computer system without need of a Bluetooth inquiry message, wherein said establishing in c) bypasses standard Bluetooth discovery processes

as recited by Claim 13.

In contrast, Larsson teaches "[w]hen the car detects an event, the car kit 160 starts transmitting inquiries at step 402" (column 3, line 60, emphasis added). Per the flowchart of Figure 4, step 402 is always executed. Accordingly, Larsson teaches performing an inquiry, in direct opposition to the instant

claimed limitations of “without... a Bluetooth inquiry message” as recited by Claim 13.

The rejection cites column 4 lines 25-40 as allegedly suggesting these instant claimed limitations. Applicants respectfully traverse. While step 430 may teach “comparing the Bluetooth address with a list of addresses corresponding to handsets that have been approved,” such comparison occurs after the Bluetooth addresses have been obtained via inquiry messages and Bluetooth discovery, as illustrated in Figure 4.

Accordingly, Larsson not only fails to teach or suggest these instant claimed limitations, but teaches directly away from these instant claimed limitations.

For this reason, Applicants respectfully assert that Claim 13 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Moreover, Larsson teaches, “[a]t step 310, the car kit 160 and phone discover each other using a low power communication scheme that is different than the communication scheme used by the cellular network. In this embodiment, that scheme is by Bluetooth” (column 3, line 26). Herein, Larsson teaches Bluetooth discovery, in direct opposition to the claimed limitations of

“bypasses standard Bluetooth discovery processes” as recited by Claim 13. It is noted that Larsson does not refute this teaching, or this aspect of this embodiment, or teach bypassing Bluetooth discovery.

Accordingly, Larsson not only fails to teach or suggest these instant claimed limitations, but teaches directly away from these instant claimed limitations.

For this additional reason, Applicants respectfully assert that Claim 13 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Further with respect to independent Claim 13, Applicants respectfully assert that Larsson fails to teach or suggest the claimed limitations of:

in response to a request from said first hand-held computer system to establish communication between said first and second hand-held computer systems, accessing said device identification of said first hand-held computer system on said second hand-held computer system

as recited by Claim 13.

The rejection concedes that Larsson does not explicitly mention that the second computer system is (a) handheld computer system. However, Larsson does more than “not explicitly mention.” Larsson teaches a second computer system that is integrated into a car, and is explicitly not “hand held,” as recited.

Larsson is directed to a radio integrated into an automobile (e.g., a “car kit”). Applicants respectfully assert that a car kit installed in an automobile fails to teach or suggest the claimed limitations of first and/or second “hand-held” computer systems. Moreover, Larsson’s teaching of car specific events, e.g., “detecting the door being opened,” leads away from hand-held devices, which do not have such features, e.g., passenger entry doors.

The Federal Circuit has ruled that “[a] *prima facie* case of obviousness can be rebutted if the applicant... can show that the art in any material respect ‘taught away’ from the claimed invention...A reference may be said to teach away when a person of ordinary skill, upon reading the reference...would be led in a direction divergent from the path that was taken by the applicant.” *In re Haruna*, 249 F.3d 1327, 58USPQ2d 1517 (Fed. Cir. 2001).

Applicants respectfully assert that one of ordinary skill, upon reading Larsson would be led to utilize a second computer system that is integrated into a car, capable of responding to car events, as taught by Larsson, and in a

direction divergent from a “second hand held computer system, as recited by Claim 13. Accordingly, Larsson teaches away.

For this further reason, Applicants respectfully assert that Claim 13 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Further still, Larsson explicitly teaches away from both devices being hand held, as recited. Larsson teaches:

A car-mounted cellular phone has certain advantages. For example, since the car-mounted phone uses an external antenna, it may get better cellular reception. An external antenna may also enable the car kit to transmit with higher power than is allowable with a hand held phone. (column 1, line 11 *et seq.*)

Thus, it is an express intent of Larsson to utilize the advantages that a car-mounted device offers over a hand held phone. Accordingly, Larsson teaches away from the rejection’s proposed modification as well as the instant claimed limitations.

For this further still reason, Applicants respectfully assert that Claim 13 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Further yet still with respect to independent Claim 13, Applicants respectfully assert that the rejection has failed to consider the reference in its entirety. For example, Larsson teaches numerous car-specific actions of the car kit, including:

any action that the car can sense, including actuating the car ignition key, a seat sensor detecting the driver sitting on the car's seat, a tilt sensor detecting the door being opened, a burglar alarm de-initiation, or any other event which can be determined by any circuitry in the car (column 3, line 50 *et seq.*, emphasis added).

Accordingly, the car kit taught by the cited reference Larsson must have numerous interfaces to various vehicle sensors. The rejection does not appear to appreciate such taught interconnections. Applicants respectfully assert that these taught car-specific functions teach away from the rejection's proposed modification to substitute a hand held device for the taught car kit.

Per *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S.851 (1984), “[a] prior art

reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”

As the cited art teaches numerous functions and requirements of a car kit, the cited art teaches away from the rejection’s proposed modification to substitute a hand held device, lacking such functions, for the taught car kit.

For this further yet still reason, Applicants respectfully assert that Claim 13 overcomes the rejections of record, and respectfully solicit allowance of this Claim.

Still yet further with respect to independent Claim 13, Applicants respectfully assert that a principle of operation of Larsson is to respond to car-specific events, e.g.,

The car senses the "event" of the user entering. The event can be sensed by any action that the car can sense, including actuating the car ignition key, a seat sensor detecting the driver sitting on the car's seat, a tilt sensor detecting the door being opened, a burglar alarm de-initiation, or any other event which can be determined by any circuitry in the car.
(column 3, line 50 *et seq.*, emphasis added)

As taught, responding to car events is a critical principle of operation of the cited art.

Per *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959), “if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

The proposed modification, to replace the “car kit” with a hand held device, would remove the ability to sense and respond to all such car events, changing this principle of operation of the primary (and only) art.

As the proposed modification of Larsson fails to establish *prima facie* obviousness, Applicants respectfully assert that all claims rejected over modified Larsson overcome the rejections of record, and respectfully solicit allowance of Claims 1-6 and 13-24.

Applicants respectfully assert that Claims 14-18 overcome the rejections of record at least by virtue of their dependence from Claim 13, and respectfully solicit allowance of these Claims.

Claims 1-3 and 19-21 are rejected for the same reasons as set forth in Claims 13-15, as method. Applicants respectfully assert that Claims 1-3 and

19-21 overcome the rejections of record for at least the rationales previously presented.

Claims 4-5, 16-17 and 22-23 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Larsson (US 6,697,638, “Larsson”) in view of Phillipps (WO 02/9362). Applicants respectfully assert that Claims 4-5, 16-17 and 22-23 are patentable over the cited art for the following reasons.

Applicants respectfully assert that Claims 4-5, 16-17 and 22-23 overcome the rejections of record at least by virtue of their dependence from Claims 1, 13 and 19 respectively, and respectfully solicit allowance of these Claims.

In addition, Applicants reiterate that all claims rejected over modified Larsson overcome the rejections of record, and respectfully solicit allowance of Claims 1-6 and 13-24, as the proposed modification changes a principle of operation of Larsson, and thus fails to establish *prima facie* obviousness.

Claims 6, 18 and 24 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Larsson (US 6,697,638, “Larsson”) in view of Johansson et al., (US 2002/0044549). Applicants respectfully assert that Claims 6, 18 and 24 are patentable over the cited art for the following reasons.

Applicants respectfully assert that Claims 6, 18 and 24 overcome the rejections of record at least by virtue of their dependence from Claims 1, 13 and 19 respectively, and respectfully solicit allowance of these Claims.

In addition, Applicants reiterate that all claims rejected over modified Larsson overcome the rejections of record, and respectfully solicit allowance of Claims 1-6 and 13-24, as the proposed modification changes a principle of operation of Larsson, and thus fails to establish *prima facie* obviousness.

CONCLUSION

Claims remaining in the present Patent Application are Claims 1-6 and 13-24. The Applicants respectfully request reconsideration of the above captioned patent application.

The Examiner is invited to contact Applicants' undersigned representative if the Examiner believes such action would expedite resolution of the present Application.

Please charge any additional fees or apply any credits to our PTO deposit account number: 504160.

Respectfully submitted,

MURABITO, HAO & BARNES LLP

Date: 3-21-2011

/Anthony C. Murabito/

Anthony C. Murabito

Reg. No. 35,295

Two North Market Street
Third Floor
San Jose, California 95113
(408) 938-9060